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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/390,740	02/17/1995	ROGER COLEMAN		7334

22428- 7590 10/20/2004

FOLEY AND LARDNER
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EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/390,740

Applicant(s)

COLEMAN ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004 and 02 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40,41,43,44,46-49,51-56,58-75,80,81,84,85 and 88-110 is/are pending in the application.
- 4a) Of the above claim(s) 43,44,48,49,51,55,56,58-75,80,81,84,85 and 88-104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40,41,46,47,52-54 and 105-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 40,41,43,44,46-49,51-56,58-75,80,81,84,85, & 88-110 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed 2/27/04 and 8/2/04, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

RESTRICTION ISSUES

Although sympathizing with applicants regarding the restriction requirement, it is pointed out that a restriction requirement was mailed to applicants as summarized in the Office action, mailed 12/28/95, which also includes a telephone election. This election was not specifically traversed at that time nor during at least the next year. Then it was acknowledged as an election without traverse in the office action, mailed 11/15/96. Since 12/28/95, and especially since 11/15/96, applicants have had years of ample time to file one or more divisional application(s) to separately pursue protein and antibody subject matter. Due to the different chemical structure of these compounds compared to the elected polynucleotide subject matter, the issues would undoubtedly have been different and patentability may have been achieved years ago for such different subject matter. Thus, any loss of years of prosecution appears to be by applicants choice not to pursue what the record indicated as independent and/or distinct inventions.

TITLE

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title only is directed to

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Chemokine PANEK-1 polynucleotides whereas the elected subject matter under examination includes a cell containing them as well as methods of detecting a target polynucleotide.

NEW MATTER

Claims 40, 41, 46, 47, 52-54, and 105-110 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The NEW MATTER rejection directed to the claims 40, 52, and 108; and claims dependent therefrom; variants directed to the insertion or deletion of 1-5 amino acids as compared to SEQ ID NO: 2 wherein specifically the variant has chemotactic activity (new but related issue as necessitated by amendment) is reiterated and maintained from the previous office action, mailed 11/25/03, with the new issue equivalent to the previous claim wording. This rejection therefore is necessitated by amendment.

Applicants argue that someone of ordinary skill in the art would understand that the 1-5 aa substitutions etc. are included as embodiments of the instant invention. In response an understanding is not a written form of subject matter and thus this argument is non-persuasive. Applicants are reminded of the "written" description requirement on which this rejection is based. It is also noted that the "and/or" optional wording in claim 40, line 7, results in polynucleotide sequences being claimed without even any activity requirement.

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PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40, 46, 47, 52, 53, and 107-110 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yoshimura et al. [FEBS Lett. 244(2):487 (1989)].

This rejection is reiterated and maintained from the previous office action, mailed 11/25/03. Applicants allege in REMARKS, filed 2/27/04, that amendments now obviate this rejection. This is an allegation without factual support and thus non-persuasive as this rejection still is deemed proper for reasons of record.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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This application contains claims 43, 44, 48, 49, 51, 55, 56, 58-75, 80, 81, 84, 85, and 88-104; drawn to an invention nonelected without traverse in the Paper, mailed 12/28/95, as acknowledged in the Paper, mailed 11/15/96. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 15, 2004


ARDIN H. MARSCHEL
PRIMARY EXAMINER 10/18/04